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Application No. 09/845,104

Remarks

Applicants thank the Examiner for his careful consideration of the application.

Claims 9 – 16 and 18 – 23 are pending in the application. **PLEASE NOTE: In neither the last office action nor the current office action has the Examiner recited a rejection to claim 22 other than on the Summary page.**

Claim Rejections – 35 USC § 103

The Examiner rejected claims 9, 10, 13 – 15, and 20 under 35 USC § 103(a) as being unpatentable over Spicer et al. (US Patent No. 7,007,093) ("Spicer") in view of Bakshi et al (US Patent No. 6,457,054) ("Bakshi"). Applicants respectfully traverse these rejections.

In claim 9, Applicants recite a method of accessing an internal network device on a protected network that includes a security device. The method includes storing data addressed to the internal network device in an external proxy server and maintaining a proxy agent on the protected network. The proxy agent polls the external proxy server for data addressed to the internal network device, forwards to the internal network device any data on the external proxy server and addressed to the internal network device, and forwards to the external proxy server any data addressed to an external device in communication with the external proxy server. Polling the external proxy server includes connecting to the external proxy server to check for pending traffic, receiving a stream of spurious bytes from the external proxy server if there is nothing pending for the internal network device, and receiving data from the external proxy server when the external proxy server has received data from a client.

The Examiner should allow claim 9 as the Examiner has not established a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). This suggestion must be found in the prior

Application No. 09/845,104

art, and cannot be based upon Applicant's disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239 (Fed. Cir. 1995), citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13 (Fed Cir. 1983).

While Applicants do not acknowledge disclosure of the elements of the claimed invention by the references, Applicants submit that the Examiner has not identified any suggestion in either of the cited references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

Claim 9 should be allowed, as the Examiner has failed to identify a suggestion in either the references or the prior art generally to combine the patents to achieve Applicant's claimed invention. The Examiner relies upon the combination of Spicer and Bakshi for the limitations present in Applicants' claim 9. The Examiner has stated that it would be obvious to combine the disclosures of these patents to achieve the invention recited in claim 9. Yet the Examiner has not provided any suggestion or motivation to combine the disclosure of Bakshi with Spicer. The Examiner has not established that the patents or the prior art in general suggests that the system for reducing user-visibility latency in network transactions of Bakshi should be combined with the network resource control system of Spicer.

There are two scenarios by which one could conclude that combining Spicer and Bakshi would be obvious. First, one skilled in the art could consider adding the disclosure of the Bakshi patent to that of the Spicer patent. The Spicer patent appears to be directed toward a network resource control system that controls access to network resources (e.g., printers) located behind a firewall. The Bakshi patent appears to be directed toward a system for reducing user-visibility latency in network transactions that includes sending a connection count during a handshake and connection phase to reduce the number of messages used for an initial TCP handshake procedure as well as the amount of time that a client device stays in a "TIME_WAIT" condition, which is used to ensure that a connection is reliably terminated. The Examiner has pointed to no part of the Spicer patent that suggests the existence of or a need to reduce the time of a handshake procedure or the existence of

Application No. 09/845,104

or a need to reduce amount of time a device client device waits before a connection is terminated. The Examiner argues that it would have been obvious to modify Spicer to include the connection count of Bakshi because the connection count "keep[s] communication channels open and thus reduces latency that would be required to establish a connection." (Final Office Action, page 3.) However, the Examiner points to nothing in Spicer or the prior art generally that suggests modifying Spicer to include the elements of Bakshi. Therefore, the Examiner has failed to establish that a person having knowledge of the Bakshi patent would be motivated to add its disclosure to the disclosure of the Spicer patent.

Alternatively, one could start with the Bakshi patent. Again, the Bakshi patent appears to be directed toward a system for reducing user-visibility latency in network transactions that includes sending a connection count during a handshake and connection phase to reduce the number of messages used for an initial TCP handshake procedure as well as the amount of time that a client device stays in a "TIME_WAIT condition, which is used to ensure that a connection is reliably terminated. The Examiner has pointed to nothing in either the Bakshi patent or the prior art that suggests any utility or advantage to incorporating a network resource control system that controls access to network resources (e.g., printers) located behind a firewall. Therefore, the Examiner has failed to establish that a person having knowledge of the Spicer patent would be motivated to add its disclosure to the disclosure of the Bakshi patent.

Since a motivation to combine was not found in either reference or the prior art generally, it is unlikely that one would have combined Spicer with Bakshi for any reason other than to create Applicant's invention. Therefore the obviousness rejection to claim 9 based upon these two references should be withdrawn.

The Examiner should allow claims 10, 13 – 15, and 20 if claim 9 is allowed as claims 10, 13 – 15, and 20 depend from claim 9.

The Examiner rejected claims 11, 12, 16, 20, 21, and 23 under 35 USC § 103(a) as being unpatentable over Spicer in view of Bakshi, and further in view of Grantges Jr. et al. (US Patent No. 6,510,464) ("Grantges"). Applicants respectfully traverse these rejections.

Application No. 09/845,104

For the reasons given with respect to claim 9, the Examiner should allow claims 11, 12, 16, 20, 21, and 23 if claim 9 is allowed as claims 11, 12, 16, 20, 21, and 23 depend from claim 9.

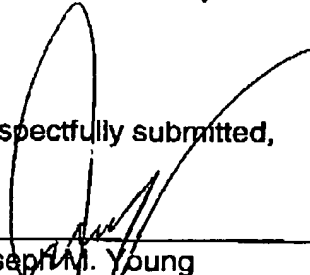
Applicants note that claim 22 was not addressed by the Examiner, but would still argue that claim 22 should be allowed if claim 9 is allowed.

Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,



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